

REMARKS

I. Status of the Claims

Claims 57-115 are pending in this application. Elected claims 57-87 and 100-114 are currently under consideration, and claims 88-99 and 115 are withdrawn as non-elected subject matter by the Office. Without prejudice or disclaimer, Applicant amends claims 57, 59, 61, 62, 64, 71, 88, 89, 91, 94, 95, 98, 100, 107, and 115. Exemplary support can be found in the specification and claims as-filed.

Accordingly, there is no written description issue.

II. Priority

The Office requires certified English translations of the two priority documents for the present application: U.S. Provisional Patent Application No. 60/560,016, filed April 7, 2004, and U.S. Provisional Patent Application No. 60/560,704, filed April 9, 2004. Office Action at page 2. Applicant concurrently submits herewith certified English translations of those two priority provisional applications in accordance with 37 C.F.R. § 1.78(a)(5) in their respective Image File Wrappers. Copies of the "Submission of English Language Translation of Provisional Application Under 37 C.F.R. § 1.52(d)(2)" coversheets from both filings are provided to the Office with the present filing. Accordingly, Applicant respectfully requests that the Office grant the present application priority to those documents.

III. Rejection Under 35 U.S.C. § 112, Second Paragraph

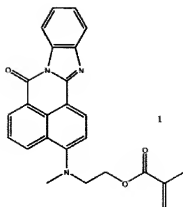
The Office rejects claims 57, 58, 61-64, 66-87, and 100-114 under 35 U.S.C. § 112, second paragraph, as allegedly "being indefinite" due to the term "carbon-based radical" recited in claims 57 and 100. Office Action at page 3. The Office further rejects

claims 59, 61, 62, and 71 under § 112, second paragraph, as allegedly “being indefinite” due to the term “hydrocarbon-based radical.” *Id.* at page 4. Applicant respectfully disagrees with both rejections. A person of ordinary skill in the chemical arts would understand those terms within the context of organic compound structures. To expedite prosecution of this application, however, Applicant amends claims 57, 59, 61, 62, 64, 71, 100, and 107 to remove the objected-to terms. Accordingly, Applicant respectfully requests that the Office withdraw the rejections under § 112, second paragraph.

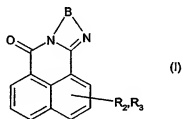
IV. Rejection Under 35 U.S.C. § 102(b) over Chen

Claims 57-64, 66-70, 82, 83, 100-106, and 108-111 are rejected under 35 U.S.C. § 102(b) as allegedly “being anticipated by” Canadian Patent Application Publication No. 2,169,713 to Chen et al. (“Chen”) for the reasons set forth in the Office Action at pages 4 and 5. Applicant respectfully disagrees and traverses the rejection.

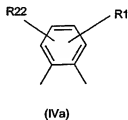
As the Office knows, a claim is anticipated only if each and every element as set forth in the claims is found, either expressly or inherently, in a single prior art reference. M.P.E.P. § 2131 (8th ed. Rev. 7, July 2008). The identical invention must be shown in as complete detail as is contained in, and must be arranged as required by, the claim. *Id.* The Chen compound fails to anticipate because it is not encompassed by the present claims. The Office contends that the following structure, shown at page 13 of Chen, anticipates the present claims:



Office Action at page 5; *see also* Chen at page 13 (compound 11). Applicant's claims 57 and 100, however, recite the following structure:



wherein B can be of formula (IVa):



and R1 is chosen from "linear, branched, and cyclic, saturated and unsaturated radicals containing 1 to 32 carbon atoms" Thus, Chen fails to anticipate because R1 in the present claims cannot be hydrogen as Chen requires. Accordingly, Applicant respectfully requests that the Office withdraw the § 102(b) rejection.

V. Rejection Under 35 U.S.C. § 103(a) over Chen

Claims 65, 71-76, 107, and 112-114 are rejected under 35 U.S.C. § 103(a) as allegedly unpatentable over Chen for the reasons set forth in the Office Action at pages 5-7. Applicant respectfully disagrees and traverses the rejection.

As the Office knows, “[t]o reach a proper determination under 35 U.S.C. § 103, the Examiner must step backward in time and into the shoes worn by the hypothetical ‘person of ordinary skill in the art’ when the invention was unknown and just before it was made.” M.P.E.P. § 2142. The Office “must then make a determination whether the claimed invention ‘as a whole’ would have been obvious at the time to that person.” *Id.* For questions of structural similarity in chemical compounds, the Federal Circuit held that a reference teaching a “potentially infinite genus” fails to establish a *prima facie* case of obviousness when that reference fails to teach the compound claimed. *See In re Jones*, 958 F.2d 347, 350 (Fed. Cir. 1992). The Federal Circuit further explained that “generalization is to be avoided insofar as specific structures are alleged to be *prima facie* obvious one from the other.” *Id.*; *see also In re Baird*, 16 F.3d 380, 382 (Fed. Cir. 1994) (finding genus encompassing more than 100 million variables without teaching or suggestion the claimed compound failed to show obviousness).

The Office first asserts that Chen “discloses polymers that teach all of the limitations of instant claim 107 except for the species of comonomer.” Office Action at page 5. Yet, as Applicant showed above, Chen fails to teach the compounds presently claimed. The Office acknowledges that picking and choosing variables within a broad genus does not give rise to anticipation. *Id.* at page 6. Thus, the Office attempts to overcome the chasm by relying on the skilled artisan as “a person of ordinary creativity.”

Id.; see *KSR v. Teleflex*, 127 S. Ct. 1727, 1742 (2007). The Office, however, seems to require the skilled artisan to be a person of *extraordinary* creativity to modify a broad genus in the way asserted to arrive at the present claims. See Office Action at page 7. It should be noted that this case involves chemical compounds rather than mechanical components as in *KSR*. 127 S. Ct. at 1742. In chemical technologies, the Federal Circuit has observed that “[t]o the extent that an art is unpredictable, as the chemical arts often are, *KSR*’s focus on . . . ‘identified, predictable solutions’ may present a difficult hurdle because potential solutions are less likely to be genuinely predictable.” *Eisai Co. Ltd. v. Dr. Reddy’s Laboratories Ltd.*, 533 F.3d 1353, 1359 (Fed. Cir. 2008). And, as discussed above, a broad genus fails to establish *prima facie* obviousness without an explicit teaching or suggestion. See *Jones*, 958 F.2d at 350.

Chen provides no suggestion to modify Chen’s 1,8-naphthalimide derivatives as the Office asserts to achieve the present claims. See Office Action at page 7. Chen teaches modification at the methacrylate end of the compound rather than the luminophore end. See Chen at pages 13 and 14. Nowhere does Chen suggest modifying the luminophore group, or that modification would even retain the desired optical properties. The skilled artisan would have no motivation or rationale to select the “various combinations of naphthalimide ligands and copolymer compositions” from Chen to arrive at the present claims, much less any expectation of success. See Office Action at page 7.

The Office further asserts that Chen discloses compounds that read on the species recited in present claim 65. *Id.* The Office again fails to show *prima facie* obviousness. Chen does not teach or suggest cosmetic compositions, but rather,

teaches polymers useful in the light-emitting layer of a light-emitting diode. *See* Chen at page 2. One of ordinary skill in the chemical arts would have no reasonable expectation that polymers used in light-emitting diodes would be at all appropriate for cosmetic compositions or even compatible with a physiologically acceptable medium.

For at least the foregoing reasons, Applicant respectfully submits that the Office fails to establish *prima facie* obviousness over Chen. As such, Applicant respectfully requests the Office to withdraw the rejection.

VI. Rejection Under 35 U.S.C. § 103(a) over Scales-Medeiros in View of Bradner and Kaul

Claims 77-81 and 84-88 are rejected under 35 U.S.C. § 103(a) as allegedly "being unpatentable over" U.S. Patent No. 5,626,839 to Scales-Medeiros ("Scales-Medeiros") in view of U.S. Patent No. 3,988,437 to Bradner ("Bradner") and International Application Publication No. WO 02/066563 to Kaul et al. ("Kaul") for the reasons set forth in the Office Action at pages 8 and 9. Applicant disagrees and traverses the rejection.

As an initial matter, none of the cited references teach the monomeric compounds or polymers presently disclosed. For that reason alone, Applicant submits that the Office fails to establish a *prima facie* case of obviousness.

Scales-Medeiros teaches a cosmetic composition comprising "[d]yes and pigments which are colorless, or have a neutral earth or skin tone color under normal lighting conditions, but emit a clearly visible contrasting color to the skin upon specific excitation. . . ." Scales-Medeiros at col. 3, ll. 40-46. The preferred dye compounds are optimally excited with a mercury vapor lamp. *Id.* at col. 5, ll. 22-25. The Office asserts

that “Scales-Medeiros teaches multiple compositions comprising dyes and pigments (column 3, lines 40-44). A combination of two of these compositions would meet the limitations of instant claims 80 and 81” Office Action at page 9. Applicant disagrees. Scales-Mederios fails to teach Applicant’s polymers, or to even suggest polymers that provide for diversities of colors having good fluorescence properties. *See* Applicant’s Specification at page 4, line 22 to page 5, line 2.

Moreover, Scales-Mederios’s fluorescent compounds are used to identify areas of the body that should not be exposed to cosmetic agent, such as the nails or palms. *See* Scales-Mederios at col. 4, line 54 to col. 5, line 7. Thus, Scales-Mederios expressly teaches against application to areas of the body that are encompassed by the present claims. *See, e.g.*, claims 86 and 87. Not only does Scales-Mederios fail to teach or suggest the present claims, it expressly teaches away from Applicant’s compositions.

In an attempt to cure the deficiencies of Scales-Mederios, the Office cites Bradner for cosmetic carrier formulations. Office Action at page 8. Yet Bradner is also silent on cosmetic compositions comprising polymers that provide for various colors for making up the hair and/or skin.

In addition, Kaul teaches the polymers for use in manufacturing printing inks. *See* Kaul at page 7, ll. 4-11. Kaul provides no motivation to use those polymers in cosmetic compositions, nor is there any suggestion that those polymers may be suitable for application to the body.

For at least the reasons provided above, Applicant submits that Scales-Mederios fails to show *prima facie* obviousness, either alone or in combination with Bradner

and/or Kaul. Accordingly, Applicant submits that the § 103(a) rejection is overcome and respectfully requests that the Office withdraw it.

VII. Double-Patenting Rejection

The Office provisionally rejects claims 57-87 and 100-114 on the ground of nonstatutory obviousness-type double patenting as allegedly "being unpatentable over" claims 57, 58, 62-68, 70-92, and 106-124 of U.S. Application No. 10/592,050. Applicant presently agrees with the double patenting rejection, and will file a suitable terminal disclaimer in the event that the pending claims are otherwise allowable.

VIII. Conclusion

Applicant submits that the Office's rejections of claims 57-87 and 100-114 are overcome in view of the foregoing remarks, and respectfully requests that those rejections be withdrawn.

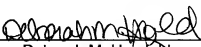
If the Examiner believes a telephone call would be useful in resolving any outstanding issues, he is respectfully invited to call the undersigned at (202) 408-4368.

If there is any fee due in connection with the filing of this paper, please charge the fee to Deposit Account No. 06-0916.

Respectfully submitted,

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GARRETT & DUNNER, L.L.P.

Dated: May 13, 2009

By: 
Deborah M. Herzfeld
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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Provisional Application of:)
Timo LUUKAS) Group Art Unit: Unassigned
Application No.: 60/560,016)
Filed: April 7, 2004) Examiner: Unassigned
For: COMPOSES MONOMERIQUE) Confirmation No. 5316
POSSEDANT DES PROPRIETES)
OPTIQUES, POLYMERES LES)
COMPRENANT ET UTILISATION) VIA EFS-WEB

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

**SUBMISSION OF ENGLISH LANGUAGE TRANSLATION OF
PROVISIONAL APPLICATION UNDER 37 C.F.R. § 1.52(d)(2)**

In response to the Office Action dated March 3, 2009, received in related non-provisional Application No. 10/593,962, Applicant hereby submits a certified English language translation of the above-identified provisional application. It is requested that this certified English language translation be placed in the file wrapper of the above-identified provisional application.

Respectfully submitted,

FINNEGAN, HENDERSON, FARABOW,
GARRETT & DUNNER, L.L.P.

Dated: May 13, 2009

By: Deborah M. Herzfeld
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